

U.S. Application No. 09/457,732
Docket No. YOR919990137US1
(YOR.080)

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MAY 08 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Andrea CALIFANO, et al.

Serial No.: 09/457,732

Group Art Unit: 2131

Filed: December 10, 1999

Examiner: La Porgia, Christian A.

For: SEMIOTIC SYSTEM AND METHOD WITH PRIVACY PROTECTION

Honorable Commissioner of Patents
Alexandria, VA 22313-1450
Box AF

PETITION FOR NEW OFFICE ACTION

Sir:

In response to the final Office Action dated March 7, 2006, Applicant respectfully requests that a new Office Action be issued, for the following reasons.

It is noted that the Examiner's Response to Arguments of the Office Action mailed March 7, 2006, is identical to the previous Response to Arguments in the Office Action mailed September 16, 2005, except for stating that:

The Applicant failed to provide sufficient evidence to assert the invention's operability, therefore, the 101 rejection stands.

(see Office Action at page 2, paragraph 5).

However, the Examiner did not state *why* or *how* the evidence presented by Applicants, or for that matter, the specifically identified disclosures in the present application which clearly contradict the Examiner's interpretation of the invention, and which clearly rebut the basis of the Examiner's assertion of inoperability, were not sufficient to show operability, or to rebut the Examiner's assertion.

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Indeed, with respect to the text of each of the rejections in the present Office Action which have been maintained (i.e., the rejection under 35 U.S.C. § 101 and 35 U.S.C. § 103), the above statement at paragraph 5 of the present Office Action is the only difference from the Response to Arguments of the previous Office Action mailed on September 16, 2005.

Moreover, the text of the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 103 are identical to the rejections set forth in the previous Office Action.

Thus, Applicants submits that the present Office Action fails to advance the prosecution of the present application.

Even assuming *arguendo* that the above statement at paragraph 5 of the present Office Action satisfies the requirement for responding to the traversal positions for the rejection under 35 U.S.C. § 101, the Office Action mailed March 7, 2006 clearly fails to take note of or answer the substance of Applicant's traversal positions with respect to the rejection under 35 U.S.C. § 103.

Applicants note that, where Applicants traverse any rejections, the Examiner should, if he repeats the rejection, take note of the Applicants' argument and answer the substance of it (see M.P.E.P. § 707.07(I); see also M.P.E.P. § 2144.08(III)).

In the Amendment under 37 C.F.R. § 1.111 filed on December 16, 2005, Applicants clearly rebutted each of the Examiner's positions with respect to both the rejection under 35 U.S.C. § 101 and 35 U.S.C. § 103. However, the Examiner did not respond to Applicants' traversal arguments, with the exception of the conclusory statement mentioned above regarding the rejection under 35 U.S.C. § 101.

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Applicants respectfully submit that the Examiner should have responded to all of Applicant's traversal positions and answered the substance of the arguments (e.g., see M.P.E.P. § 707.07(f); see also M.P.E.P. § 2144.08(III)).

That is, the Examiner should have responded to each of Applicants' traversal positions with respect to the rejection under 35 U.S.C. § 101 on pages 16-19 of the Amendment under 37 C.F.R. § 1.111 filed on December 16, 2005.

Moreover, the Examiner should have responded to each of Applicants' traversal positions with respect to the rejection under 35 U.S.C. § 103 on pages 21-26 of the Amendment under 37 C.F.R. § 1.111 filed on December 16, 2005.

For the foregoing reasons, Applicants submits that the present Office Action fails to advance the prosecution of the present application, since the Office Action does not properly take note of Applicants' argument or answer the substance of those traversal positions.

Thus, Applicants respectfully Petition for the issuance of a New Office Action which properly responds to each of Applicants' traversal positions and answers the substance of those arguments in compliance with M.P.E.P. § 707.07(f) and § 2144.08(III), in order to advance the prosecution of the present application.


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It is believed that no petition or fee is required. However, if the USPTO deems otherwise, the Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: MAY 8, 2006


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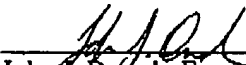
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CERTIFICATE OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 the enclosed Petition for New Office Action to Examiner Christian A. La Forgia on May 8, 2006.


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